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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,447	10/16/2003	David S. Benco	LUC-431/Benco 31-23-23-25	8753
32205	7590	11/30/2005	EXAMINER ZEWDU, MELESS NMN	
CARMEN B. PATTI & ASSOCIATES, LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			ART UNIT 2683	PAPER NUMBER

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	✓	<b>Applicant(s)</b>
	10/687,447		BENCO ET AL.
	<b>Examiner</b> Meless N. Zewdu	<b>Art Unit</b> 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,8-10 and 14-17 is/are rejected.
- 7) Claim(s) 5-7,11-13 and 18-20 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

## DETAILED ACTION

1. This action is the first on the merit of the instant application.
2. Claims 1-20 are pending in this action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamada (US 2002/0123336 A1) in view of Cohen et al. (Cohen) (US 2004/0110494 A1). Independent claims are considered first beginning with claim 1.

**As per claim 1:** Kamada discloses a method for a network to send a notification to subscribers regarding a service subscription status (page 7, paragraph 0092) comprising the steps of:

generating a notification message regarding a subscription (see page 7, col. 1, paragraphs 0090-0091);

sending the notification message to at least one mobile subscriber (see page 7, col. 1, paragraph 0092);

storing the new feature (see page 1, col. 2, paragraph 0013-0014) with an expiration time in a subscriber database (see figs. 6 and 7; page 2, col. 1, paragraph 0019);

detecting, by the network, an end of the expiration time for the at least one mobile subscriber (see page 7, col. 1, paragraph 0090) ; and

sending, by the network, a feature expiration notification message to the at least one mobile subscriber regarding subscribing to the new feature (see page 7, col. 1, paragraph 0091). But, Kamada does not explicitly teach about sending a response to the network that indicates that the at least one mobile subscriber desires to try the new feature, as claimed by applicant. However, in a related field of endeavor, Cohen teaches about providing enhanced software service for subscribing customers, on trial basis, wherein a customer who finds the service desirable responds to the service provider via SMS (page 3, col. 1, paragraph 0023). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Kamada with that of Cohen so that the trial period, which is subject to expiration, would not be elapsed (see page 3, col. 1, paragraph 0024).

**As per claim 8:** Kamada teaches:

introducing a new feature in the network (see page 1, paragraph 0014);  
automatically generating a notification message regarding the new feature introduction (see page 1, paragraph 0014; page 7, paragraph 0092).  
the feature expiration notification message containing an offer to subscribe to the new feature ( see page 7, paragraph 0092). All other features of claim 8 are similar to

the features of claim 1. Hence, the similar features of claim 8 are rejected on the same ground and motivation as claim 1.

**As per claim 14:** Kamada teaches:

a notification message regarding a new feature introduction by the network (see page 1, paragraph 0014; page 7, paragraph 0092).

the notification message offering the new feature for trial period to at least one mobile subscriber (see page 7, paragraphs 0092 and 0100).

a subscriber database in which is stored an expiration time for the trial time period (see fig. 1, element 96; figs. 6 and 7; page 3, paragraph 0048).

a feature expiration notification message containing an offer to subscribe to the new feature ( see page 7, paragraph 0092). All other features of claim 14 are similar to the features of claim 1. Hence, the similar features of claim 14 are rejected on the same ground and motivation as claim 1.

**As per claim 3:** Kamada teaches a method, wherein the feature expiration notification message is sent to the at least one mobile subscriber in at least one of a form of Short Message Service, a form for a display on a mobile device of the at least one subscriber, and voice mail for the at least one subscriber (see page 7, paragraph 0092). The prior art satisfies the at least one of a display on a mobile device.

**As per claim 9:** the feature of claim 9 is similar to the feature of claim 3. Hence, claim 9 is rejected on the same ground and motivation as claim 3.

**As per claim 16:** the feature of claim 16 is similar to the feature of claim 3. Hence, claim 16 is rejected on the same ground and motivation as claim 3.

Claims 2, 4, 10, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claim 1 above, and further in view of Dumont et al. (Dumont) (US 2005/0064884 A1).

**As per claim 2:** but, the above references do not explicitly teach about a method, wherein generation of a notification message regarding the new feature occurs automatically in response to the introduction of the new feature in the network, as claimed by applicant. However, in a related field of endeavor, Dumont teaches about optimized message notification, wherein a server selectively sends out a notification to a message recipient when a new message is available (see abstract; page 2, paragraphs 0021-0025). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Dumont for the advantage of having an optimized message service (see page 1, paragraph 0002).

**As per claim 4:** Cohen teaches a method, wherein the method further comprises the steps of:

electing, by the at least one mobile subscriber, to subscribe to the new feature (see page 3, paragraph 0023). Signing, as provided in the prior art, is the effect of electing.

sending, by the at least one mobile subscriber, a feature election message to the network (see page 3, paragraph 0023); and

removing by the network, from the subscriber database the expiration time for

the new feature (see page 3, paragraph 0025). The phrase, beyond the trial period, implicitly indicates termination/removal of service/access to service, if a subscriber does not sign.

**As per claim 10:** the feature of claim 10 is similar to the feature of claim 4. Hence, claim 10 is rejected on the same ground and motivation as claim 4.

**As per claim 15:** the feature of claim 15 is similar to the feature of claim 2. Hence, claim 15 is rejected on the same ground and motivation as claim 2.

**As per claim 17:** the feature of claim 17 is similar to the feature of claim 4. Hence, claim 17 is rejected on the same ground and motivation as claim 4.

### ***Allowable Subject Matter***

Claims 5-7, 11-13 and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Meless zewdu



Examiner

21 November 2005.